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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,153	09/23/2003	Mark C. Nicely	14522-004001	2854
26181	7590	06/01/2007		
FISH & RICHARDSON P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER DUFFY, DAVID W	
			ART UNIT 3714	PAPER NUMBER
			MAIL DATE 06/01/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/670,153

Applicant(s)

NICELY ET AL.

Examiner

David W. Duffy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent-term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 19-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 19-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 6, 2007 has been entered.

### ***Status of Claims***

2. This action is in response to the amendment filed October 2, 2006. Claims 1-17 and 19-29 are pending.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-17 and 19-29 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for adjusting the percentage of a wager deposited to the progressive jackpot pool, does not reasonably provide enablement for providing adjustment of the percentage in response to a wager. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The specification does not explain or state rebalancing the withholding

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percentage in response to a wager or received data. A search and reading of the specification fails to find the word response present. Rather, the specification seems to be describing the adjustment of withholding percent for an entire bonus game and not on a wager-by-wager basis.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-17 and 19-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. The claims all cite the limitation change the percentage of the wager amount to be applied to the progressive jackpot such that a product of a wager amount necessary to participate in a progressive jackpot, an odds of winning the progressive jackpot, and the changed percentage of the wager amount to be applied to the progressive jackpot is equal for the first and second gaming system in response to either a wager or data received. It is unclear how any wager or data received would alter the ratio of the three fixed numbers for the two or more gaming systems. The specification does not describe altering the ratio in response to any change of data, but rather describes setting the values for a bonus round based on the bet *required* to participate in the game (which appears to be a constant for at least the bonus period as described by the specification), the odds of winning (which is also assumed to be constant as detailed by the specification) and the *percentage* of the wager added to the jackpot pool. While the *amount* of a wager added to the pool would vary dependant on the wager, examiner

could find no explanation for why the *percentage* would also vary in response to an individual wager. Examiner is interpreting the claims in light of the specification which seems to be describing a system where the withholding rate is set such that all gaming machines pay in equal amounts to the bonus pool regardless of denomination or currency and is examining as such.

***Claim Rejections - 35 USC § 102***

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 1-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Torango (US 6241608).

10. In regards to claims 1 and 14, Torango discloses a system for managing a progressive jackpot comprising an interface (9:17-19) and a progressive engine that monitors game wager data to set the product of the contribution percent, odds of winning, and wager amount equal for all gaming devices by changing the contribution percent (6:12-17, Contribution percent; 7:43-45, Surcharge Percent; 7:56-66, Total Wager Amount; 13:60-14:21, where total wager amount = wager \* odds and the surcharge percent is the change in percent contributed to the bonus pool).

11. In regards to claim 2, Torango discloses that the system is operable to incorporate many gaming systems with various parameters into one jackpot (figure 1 and 11:38-53).

12. In regards to claim 3, Torango discloses a network for the system to operate within (8:40-44).

13. In regards to claims 4 and 5, Torango discloses currency conversion done in real time (17:32-43).

14. In regards to claims 6 and 7, Torango discloses displaying jackpot information to players in real time (16:41-43).

15. In regards to claim 8, Torango discloses resetting the value of the jackpot after a win (21:30-31).

16. In regards to claim 9, 10, 20 and 21, Torango discloses a first game with parameters, a second game system with parameters different from the first participating in a progressive jackpot, whereby in response to wager amounts (total wager amount), the system analyses the parameters and changes the percentage of a wager to apply to the jackpot to make the contributions equal (surcharge percent) (12:66-14:20).

17. In regards to claim 11, Torango discloses multiple gaming machines, which would also include a third game (figure 1).

18. In regards to claim 12, Torango discloses that odds are included in the game parameters (7:56-66).

19. In regards to claim 13, Torango discloses the parameters include currency type (17:23-31).

20. In regards to claim 15, Torango discloses one or more gaming systems seeking participation in a jackpot, analyzing the game systems' characteristics, converting currency, changing the jackpot contributions to make total contributions equal (12:66-14:20) and further identifies a source of wager amounts, determines the value to add to the jackpot and adds that value to the jackpot (17:14-43).

21. In regards to claim 16, Torango discloses validating the payout parameters of gaming systems by verifying game odds and payoff are consistent and within predetermined criteria and including validated games in the jackpot (12:66-14:20, note linking is not done if game system is not within acceptable ranges).

22. In regards to claim 17, Torango discloses a first server; a second server and a progressive jackpot manager networked where the game servers have one or more game systems connected (Figure 1).

23. In regards to claims 19 and 23, Torango discloses receiving data concerning a wager amount of a user of a gaming system (total wager amount), changing the percentage of a wager to be added to the progressive jackpot (surcharge percentage) such that contribution is equal for all gaming systems (12:66-14:20), incrementing the jackpot by the resultant amount (17:32-43), executing a random number generator using odds from the game system and transmitting the results to the gaming system (15:60-26).

24. In regards to claim 20, Torango discloses calculating the surcharge percentage through retrieval of previous analysis (13:11-67).

25. In regards to claims 24-29, Torango discloses identifying a source of wager amounts, determining the value to add to the jackpot and adding that value to the jackpot (17:14-43).

### ***Response to Arguments***

26. Applicant's arguments with respect to claims 1-29 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 2004/0038735 to Steil et al directed to an equalized progressive gaming system.

Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including: "The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. A general allegation that the claims "define a patentable invention" without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. Moreover, "The prompt development of a clear Issue requires that the replies of the applicant meet the objections to and rejections of the claims." Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06 II(A), MPEP 2163.06 and MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.

Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as



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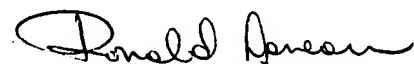
well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David W. Duffy whose telephone number is (571) 272-1574. The examiner can normally be reached on M-F 0800-1630.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DWD



RONALD LANEAU  
PRIMARY EXAMINER

5/28/07